

### REMARKS

Claims 93-94 and 97-107 are pending in the action, with claims 93, 97, 100 and 106 being independent. Claims 93, 97-101 and 103-107 are amended. No new matter has been added. Claims 1, 12, 75-92 and 108-139 are canceled, without prejudice or disclaimer of the subject matter recited therein.

The specification is objected to because of minor informalities.

Claims 93, 97-101 and 103-107 are objected to because of minor informalities.

Claim 93 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over USP No. 6,343,327 to **Daniels** in view of USP No. 7,051,003 to **Kobata**.

Claims 94 and 97-99 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over **Daniels** in view of **Kobata**, and further in view of USP No. 6,023,700 to **Owens**.

Claims 100 and 103-105 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over **Daniels** in view of **Kobata**, and further in view of USP No. 6,697,944 to **Jones**.

Claims 101-102 and 106-107 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over **Daniels** in view of **Kobata** and **Jones**, and further in view of USP No. 6,865,191 to **Bengtsson**.

Applicant respectfully traverses these rejections. Reconsideration and allowance of the above-referenced application are respectfully requested in light of the following comments and remarks.

### **Oath/Declaration**

In response to the Examiner's remarks in regards to the declaration submitted on July 8, 2003, Applicant notes that the declaration is a copy retrieved from the parent application (U.S. Serial No. 09/595,416, now USP No. 6,732,101) and is in compliance with 37 C.F.R. § 1.63(d)(1)(iv). Applicant respectfully submits that there is no need to revise the bibliographic

data on the declaration in order to disclose the continuation information for the instant application.

Accordingly, Applicant respectfully requests the Examiner's reconsideration thereof, without requiring a new declaration to be filed.

### **Objections to the Specification**

The Examiner has objected to the amended specification because of minor informalities. In response, Applicant has amended the specification as suggested by the Examiner. Withdrawal of the objection to the specification is respectfully requested in view of this amendment.

Also, in this regard, Applicant respectfully requests that the Examiner indicate that the drawing sheets 1-16 (FIGS. 1-6) filed on July 8, 2003 are acceptable.

### **Objections to the Claims**

The Examiner has objected to claims 93, 97-101 and 103-107. In response, Applicant has amended these claims as proposed by the Examiner. Withdrawal of the objections to the claims is respectfully requested in view of the amendment to these claims.

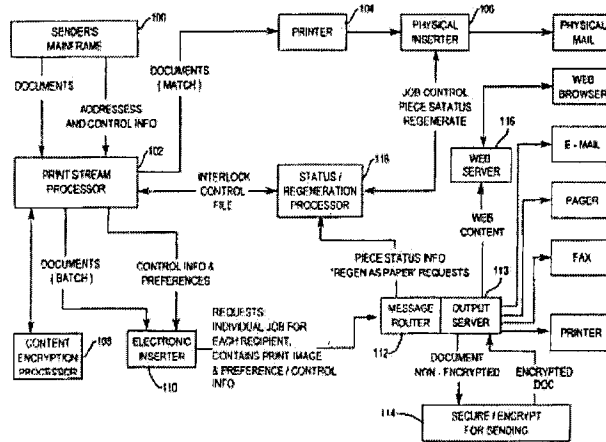
### **Section 103(a) Rejections**

Claim 93 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over **Daniels** in view of **Kobata**. Applicant respectfully traverses the rejection.

Claim 93, recites in part sending an encrypted message to a forwarding server, including providing **a list of recipients** to the forwarding server.

In the statement of rejection, the Examiner identifies Daniel's control information and preference information forwarded to a message router 112 as containing a list of recipients (see, page 4, lines 7-9 of Office Action).

Daniels describes a printstream processor 102 that processes documents using one of two delivery mechanisms: a physical delivery mechanism (e.g., via U.S. Postal Service or other courier services) or an electronic delivery mechanism (e.g., via the web) (3:45-53).



As shown in the figure above, the processor 102 utilizes a customer database 202 that indicates how each document for each recipient is to be delivered (e.g., fax, pager, email, web browser, etc.) (4:46-49). Control information 204 is also input to the processor 102 that specifies processing instructions, including, for example, determining which inserts (e.g., ads, envelopes, etc.) are to be included with the documents and whether to presort the documents (4:49-52). Documents are then sent to a message router 112 for delivery based on the delivery mechanism specified in the customer database 202.

Claim 93 recites in part "providing a list of recipients to the forwarding server", while Daniels discloses sending "control information" and "preference information" to the message router 102. Applicant respectfully submits that neither the control information nor the preference information contain a list of recipients. As explicitly disclosed in Daniels, control information specifies what inserts are to be included with each document in the printstream (3:30-31). For example, an insert may include a brochure describing a ski resort in Vermont (5:7-9). Documents designated for a particular delivery are extracted and combined with appropriate inserts based on the control information (4:1-5). The control information, however, does not specify any intended recipient, or include a list of recipients for whom the documents are to be delivered.

While Daniels' preference information includes addressing information, such addressing information only specifies a delivery means by which a document is to be delivered. For

example, as indicated in Daniels, if the delivery preference specifies that an electronic mail piece is to be delivered to a web server 116, then the output server 116 sends the electronic mail piece to the web server 116 (7:6-9). The preference information does not specify to whom the mail piece is to be delivered.

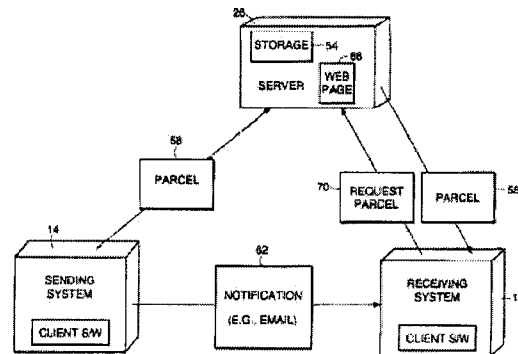
There is nothing in Daniels that suggests that any recipient name is sent to the message router 112. Daniels' physical delivery information such as zip code, account identifier, address and name of a recipient is stored in a mail run datafile 220 (5:9-13) or electronic mail run datafile 222 (5:23:26 and 5:31-35). The mail run datafile 220, however, is not sent to the message router 112. Rather, the mail run datafile 220 is used by a printer 104 and physical inserter 106 (or electronic inserter 110) for generating physical mail pieces with selected inserts and the proper physical mail address (5:13-16). Similarly, physical delivery information stored in the electronic mail run datafile 222 is attached to a respective electronic mail piece by the electronic inserter 110 (5:33-35).

Kobata does not remedy the deficiency in Daniels. Kobata's sending system 14 sends a parcel 58 to the server system 26. The server system 26 stores the parcel 58 in a storage system (6:25-26), and notifies the receiving system 18 that the parcel 58 can be retrieved (e.g., provides an URL of the server system 26 through which the parcel 58 can be retrieved, see, 6:8-15). In response to the notification, the receiving system 18 access the server system 26 to request the parcel 58 (6:25-29). Kobata does not send any recipient name (or list of recipients) to the server system 26, as the intended recipient is directly notified by Kobata's sending system 14 that a parcel 58 is available to be picked up.

Claim 93 also recites at the forwarding server, decrypting a received encrypted message and **determining a delivery preference** for each recipient in the list of recipients.

The Examiner has admitted that Daniels does not disclose or suggest these features, and relies on Kobata to cure these deficiencies in Daniels.

As a preliminary matter, Applicant reiterates that neither Daniels nor Kobata teach or suggest a list of recipients. Applicant respectfully submits that Kobata also does not teach or suggest determining a delivery preference for each recipient in a list of recipients.



As shown in the figure above, Kobata's receiving system 18 is directly notified by the sending system 14 (e.g., via notification 62), at which point the receiving system 18 accesses the server system 26 (e.g., via request 70 and logging onto the server system 26, see, 10:35-48) to retrieve the parcel 58 intended for the receiving system 18. The server system 26 does not determine any delivery preference for the receiving system 18, and the receiving system 18 does not communicate with the server system 26 at any point in time to specify any delivery preference, as the parcel 58 is manually retrieved from the storage system 54.

Therefore, Applicant respectfully submits that claim 93 is allowable for at least one of the reasons set forth above. Claims 94 and 99 depend on claim 93, and also are submitted to be allowable for similar reasons discussed above with respect to claim 93.

### Section 103(a) Rejections

Claim 97 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over **Daniels** in view of **Kobata**, and further in view of **Owens**.

Claim 97 recites in part a forwarding engine executing on a computer operable to: notify the recipient that the message is available for retrieval for each recipient that does not have a delivery preference.

The Examiner has admitted that neither Daniels and Kobata teach or suggest that for each recipient that does not have a delivery preference, the recipient is notified that a message is

available for retrieval (see, page 7, lines 16-18 of Office Action). The Examiner has identified col. 5, lines 37-44 of Owens as disclosing these features.

Applicant respectfully submits that Owens teaches away from the claimed invention. Owens describes forwarding mail messages (e.g., emails) to a telecommunications service 12 (4:26-31). The electronic mail distributor 14 first receives a message 16 from a message sender 18, and determines whether the intended recipient of the message 16 has specified rules 24 indicating how the message 16 is to be forwarded to the telecommunications service 12 for later retrieval via a telephone (4:40-48). If the recipient has specified a preference for receiving the message 16 at the telecommunication services 12, the message 16 is modified by the electronic mail distributor 14 to include telecommunications service routing information 26 (4:48-53). Else, electronic mail distributor 14 forwards the message 16 to the recipient's mailbox 48 at the electronic mail service 10 (5:37-42), or to the Internet or another electronic mail service 52 (5:44-46).

Owens does not teach or suggest notifying a recipient that a message is available for retrieval if a delivery preference has not been specified by the recipient. By contrast, Owens teaches away from the claimed invention by forwarding the message to the recipient's electronic mailbox 48 or other electronic storage means if the recipient has not indicated any delivery preference. Owens does not teach or suggest notifying the recipient that a message is available for retrieval.

Therefore, Applicant respectfully submits that claim 97 is allowable for at least one of the reasons set forth above. Claim 98 depends on claim 97, and also is submitted to be allowable for similar reasons discussed above with respect to claim 97.

### **Section 103(a) Rejections**

Claim 100 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over **Daniels** in view of **Kobata**, and further in view of **Jones**.

Claim 100 recites in part for each recipient, re-encrypting the decrypted message according to the decryption capability of the recipient.

In the statement of rejection, the Examiner has acknowledged that neither Daniels nor Kobata teach or suggest re-encrypting a decrypted message according to the decryption capability of a recipient. The Examiner relies wholly on the section at col. 4, lines 30-35 of Jones to cure these deficiencies in Daniels and Kobata. The section reads:

Other players may include "personalized" decryption capability wherein a digital content file may be encrypted with the device's public key prior to the transfer of that information to the portable device. The portable device is then able to decrypt the digital content information prior to playback using its private key.

Applicant respectfully submits that this section of Jones does not disclose " re-encrypting a decrypted message". Applicant respectfully submits that Jones discloses only a single instance of encryption and decryption, which is cumulative to the disclosure of Daniels and Kobata. Specifically, Jones describes that the digital content provider 60 may interrogate a user's device 64 to determine the level at which the device 64 is to be trusted with digital content (e.g., music files) so as to limit the user's ability to engage in illegal redistribution of the content (8:53-58). The provider 60 may use the user's public key to encrypt the digital content such that its playback could only be effectuated by the user's device 64 by decrypting the digital content with its private key during playback (8:62-65). At best, Jones' content provider 60 only encrypts the digital content, and subsequently sends the encrypted content to the user device 64 to be decrypted for playback. Jones, however, does not re-encrypt the decrypted digital content for any purpose or by any means.

Also, while Jones checks the trust level of the user device 64, Jones does not determine the decryption capability of the use device 64. The disclosure of Jones does not discuss how decryption capability is determined, as further supported by the absence of the Examiner's explanation. Also, Applicant respectfully submits that determining the trust level of a device is wholly distinct from determining the decryption capability of the device, as the determination of the device's trust level relates to authorization while the determination of the device's decryption capability relates to enablement once the trust level has been determined.

Applicant notes that the Examiner has attempted to reconstruct the claimed invention by stitching parts of the disclosure of Daniels, Kobata and Jones to arrive at the claimed invention

(e.g., Kobata is alleged to show decrypting an encrypted message and delivering the message to a recipient, while Jones is alleged to show determining a decryption capability for each recipient and re-encrypting an decrypted message). Applicant respectfully reminds the Examiner that hindsight reconstruction using Applicant's claims as a template to reconstruct the invention by **picking and choosing** isolated disclosures from the prior art is impermissible. For example, in *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), the Federal Circuit stated:

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. (citations and quotations omitted)

The Examiner has attempted to show only that the elements of the claimed invention are **individually** known without providing a *prima facie* showing of obviousness that the **combination** of the claimed elements is known or suggested in the prior art.

For at least the foregoing reasons, Applicant respectfully submits that claim 100 is allowable for at least one of the reasons set forth above. Claims 101-105 depend on claim 100, and also are submitted to be allowable for similar reasons discussed above with respect to claims 101-105.

### **Section 103(a) Rejections**

Claim 106 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over **Daniels** in view of **Kobata** and **Jones**, and further in view of **Bengtsson**.

Claim 106 recites in part for each recipient, re-encrypting the decrypted message according to the decryption capability of the recipient.

In the statement of rejection, the Examiner has acknowledged that neither Daniels, Kobata nor Jones teach or suggest these limitations. The Examiner relies wholly on the section at col. 6, lines 60-67 of Bengtsson to cure these deficiencies in Daniels, Kobata and Jones (see, page 14, line 21 to page 15, line 5 of Office Action). The section reads:



While the sender of the SMS message and its attachment may be familiar with the capabilities of the recipient's terminal, this is not required. If, for example, the sender transmits an attachment that the receiver's terminal 34 does not have the capability to decipher and/or output, the WAP technology can negotiate with the server 32 to deliver the message in a format that is understood by the terminal 34. If the recipient doesn't have a WAP terminal, then the attached file could be accessed through the Internet as an ordinary HTML file.

Applicant respectfully submits that there is nothing in this section of Bengtsson which might suggest re-encrypting a decrypted message according to a decryption capability of a recipient. First, Bengtsson does not use the word "encryption" or "decryption" at all. The word "encryption" or "decryption" does not occur at all in the description of Bengtsson.

Secondly, at the cited section, Bengtsson describes that if a recipient terminal 34 cannot decipher an attachment (e.g., image file or audio file), the wireless access protocol "WAP" can negotiate with the server 32 that stores the attachment (see, 5:45-52) to deliver an attachment in a format that can be understood by the recipient terminal 34. There is no disclosure in Bengtsson, however, that points to any encryption or decryption capability of the server 32 to encrypt or decrypt a message, or any notification sent to the recipient terminal 34 to retrieve a message if the recipient terminal 34 does not possess decryption capability.

For at least the foregoing reasons, Applicant respectfully submits that claim 106 is allowable for at least one of the reasons set forth above. Claim 107 depends on claim 106, and also is submitted to be allowable for similar reasons discussed above with respect to claim 106.

### Conclusion

Applicant respectfully requests that all pending claims be allowed.

By responding in the foregoing remarks only to particular positions taken by the Examiner, Applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, Applicant's arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist.

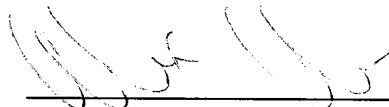
For all of the reasons set forth above, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicant's representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 06-1050 and please credit any excess fees to such deposit account.

Respectfully submitted,

Date: 6/19/07

  
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